

REMARKS

Claims 1-8 stand finally rejected under 35 USC §102(a) as having been anticipated by an article entitled “FASTBALL.com’s ‘Decode & Win Game”, by Debra Ray, which was published on November 1997 (Dialog 01539026 01-90014). As set forth in the response filed on November 13, 2007, the Examiner properly noted that the article by Ms. Ray describes that FASTBALL.com’s Decode & Win Game proved that a compelling promotion can not only generate trial, but also bring repeat visitors or players to an online service or website in order to increase traffic at the web site. As previously acknowledged, and without going into the detail present in the Office Action, suffice it to say that the Applicants concur with the Examiner’s interpretation of the contents of the article.

Notwithstanding the foregoing acknowledgment as to the content of Ms. Ray’s article, what the Examiner did not learn from the article was that Ms. Ray was merely acting as a reporter, who was reporting on a promotion which used by Cox Interactive Media. The article refers to the decoder as being “... a patent-pending decoder device ...” In fact, the patent application referred to in the article was the parent of the present application, namely, U.S. Ser. No. 09/081,795 (“the ‘795 Application”), now U.S. Patent No. 5,984,367 (“the ‘367 Patent”), which was filed on May 20, 1998 by Mr. Barnhart and Mr. Brooks, the named inventors of the present application. Thus, while the article incorrectly reported that the game piece was “patent pending”, the actual patent application which was the parent of the present application, was not filed until about five months following the date of the article.

Further, the article refers to the decoder as having been created by Promotions Unlimited, Inc., which was a company in which one of the joint inventors in the present application, namely, Thomas Barnhart, was a principal. His wife, Sharon Barnhart was the registered agent, as shown by the annual corporate filing made in the Office of the Secretary of State of Georgia by Mrs. Barnhart, as the agent for Promotions Unlimited, Inc. which was previously made of record.

In issuing the Final Rejection, the Examiner stated two things – firstly, that an Affidavit was needed; and, secondly, that the applicant’s response was “not plausible”.

With respect to the request for an affidavit, the Declaration of Joel Brooks is being filed herewith. As set forth therein, Mr. Brooks, one of the named inventors in the present application, was also one of the inventors in U.S. Patent No. 5,984,367 entitled “Hidden Image Game Piece” which issued on November 16, 1999 based on Application Ser. No. 09/081,795, filed May 20, 1998. As set forth in Mr. Brooks’ declaration, the decoder device which was used in the Cox Promotion, as described in the article by Debra Ray was made by him. As of November 1997 there was no pending patent application, although the article states that there was one. That statement in the article was incorrect, and it must be assumed that Ms. Ray was told that a patent application was planned (as, in fact, it was, as evidenced by the filing of the application thereafter).

With respect to the Examiner’s statement that “... the Applicant’s response is not plausible...” undersigned counsel respectfully requests that the Examiner apologize for that totally inappropriate comment in the official record. Specifically, the word “plausible” means “truthful”, and for the Examiner to state that undersigned was anything

other than truthful is totally inappropriate, particularly given that everything stated in the prior response has now been verified by the accompanying Declaration of Mr. Brooks.

The Examiner's attention is respectfully directed to 37 C.F.R. § 1.3, which requires that applicants and their attorneys conduct their business with decorum and courtesy. While that section of the "Rules of Practice" does not require that examiners also act with decorum and courtesy, in my 38 years of practice before the PTO, I have never, before, been accused of lying, and I trust that the Examiner's choice of words was unintentional. Accordingly, an apology is hereby solicited.

In view of the foregoing, it is clear that the rejection of the application, under 35 U.S.C. §102(a) is improper, as the invention was not known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent. In fact, the very article to which the Examiner made reference reports on the work of the present inventors, who claimed the priority of their earlier filed application.

Based on the foregoing, the present application is now in condition for allowance, and such action is respectfully solicited.

Respectfully submitted,

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Attachment: Declaration of Joel Brooks

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